

REMARKS

In the Office Action of October 28, 2004, the Examiner has rejected claims 49-51 and 53-59 under 35 USC 102(e) as being anticipated by Okuniewicz U.S. Patent No. 6,585,589 which claims priority to Okuniewicz U.S. Patent No. 6,146,276 (collectively referred to herein as the "Okuniewicz" patents).

In this present amendment, the Applicants have cancelled claims 49-51, 53-56 and 58.

Claims 57 and 59 are now the only remaining claims pending in this application.

According to the Federal Circuit, "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." W.L. Gore & Assocs. V. Garlock, Inc. 220 USPQ 303, 313 (Fed. Cir. 1983). Furthermore, it is not enough that the reference disclose all of the claimed elements in isolation. Rather, as stated by the Federal Circuit, the prior art reference must disclose each element of the claimed invention arranged as in the claim. Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984). The exclusion of a claimed element from a prior art reference is enough to negate anticipation. Connell v. Sears, Roebuck & Co., 220 U.S. P.Q. 193,198 (Fed. Cir. 1983). In order for anticipation to exists, the Examiner

must clearly show that the missing element not described in the cited reference is necessarily present in the apparatus described in the cited reference. Continental Can Co. USA v. Monsanto Co., 20 USPQ2d 1746, 1749-50 (Fed. Cir. 1991). When an Examiner relies on "inherency", it is incumbent on the Examiner to point to the page and line of the prior art which justifies an inherency theory. Ex parte Schriker, 56 USPQ2d 1723 (B.P.A.I. 2000) (unpublished). Functional limitations in a claim cannot be ignored when determining whether anticipation exists. (see In re Land, 151 USPQ 621 (C.C.P.A. 1966))

Applicants submit that the Okuniewicz patents do not disclose certain elements recited in claims 57 and 59 and therefore, cannot anticipate claims 57 and 59. Claim 57 is directed to a gaming apparatus and recites several elements which include:

a lottery game module in electronic data communication with the operational control circuitry of the electronic gaming machine and comprising microprocessor means to graphically generate a lottery drawing upon the occurrence of a predetermined event on the electronic gaming machine and means for storing data defining at least one predetermined event that must occur on the electronic gaming machine in order for the microprocessor means to graphically generate the lottery drawing;

a display device to display the graphically generated lottery drawing;

Neither of the Okuniewicz patents discloses the recited "lottery game module" and the "display device". Applicants submit that when considering the relevant case law on anticipation, as described above, neither of the Okuniewicz patents anticipate claim 57.

Claim 59 is directed to a "gaming machine configured to generate a casino game of chance and a simulated lottery drawing". Among the elements recited in claim 59, this claim recites:

electronic circuitry means configured to generate a casino game of chance and a simulated lottery drawing;

means for controlling the electronic circuitry means to generate the simulated lottery drawing upon the occurrence of the predetermined event;

a display device to display the simulated lottery drawing;

Neither of the Okuniewicz patents discloses the recited "electronic circuitry means", the "means for controlling", and the "display device". Applicants submit that when considering the relevant case law on anticipation, as described above, neither of the Okuniewicz patents anticipate claim 59.

Thus, Applicants submit that claims 57 and 59 are not anticipated by the cited Okuniewicz patents and are patentable over both of these cited Okuniewicz patents.


Reconsideration and allowance of claim 57 and 59 are therefore earnestly solicited.

Applicants encourage the Examiner to call the undersigned attorney if there is any matter or issue that can be resolved through a telephone conference.

A Petition for Extension of Time for one month and the appropriate fee are attached hereto.

Respectfully submitted,

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